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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,589	09/18/2003	Roger P. Jackson	10,251	1926

7590 06/27/2005

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EXAMINER

RAMANA, ANURADHA

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/666,589	Applicant(s) JACKSON, ROGER P.	
	Examiner Anu Ramana	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/18/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 19-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Shapiro et al. (US 6,436,139).

Shapiro et al. disclose a threaded interbody spacer 10 with opposite lateral concave surfaces (Figs. 1, 7 and 8, col. 3, lines 26-67 and col. 4, lines 1-38).

Claims 1-2, 6-12, 14, 18-21 and 24-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Michelson (US 6,120,503).

Michelson discloses an interbody spacer 40 and a stabilizing structure or end cap 14 with wing portions (16, 17) and a pawl 35 received in a recess 44 of the implant (Fig. 9, col. 2, lines 27-58, col. 6, lines 46-67, cols. 7-8 and col. 9, lines 1-22).

The method steps of claims 28 and 29 are performed when the Michelson implant is utilized for spinal fixation.

Claims 1-2, 6-14, 18-20 and 24-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Ray (US 6,306,170).

Ray discloses a spacer with an anchoring plate or "end cap" 26 having wing portions 60 and detents or pawls 42 received in slots 44 (col. 3, lines 49-67, col. 4 and col. 5, lines 1-56).

The method steps of claims 28 and 29 are performed when the Michelson implant is utilized for spinal fixation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-18 and 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro et al. (US 6,436,139), as applied to claims 1 and 19, in view of Michelson (US 6,120,503).

Shapiro et al. disclose all elements of the claimed invention except for an end cap member or stabilizing structure with wing portions.

Michelson teaches an end cap or stabilizing structure 12 with wing portions (16, 17) and a resilient pawl 35 received in a recess 44 of a spinal implant to prevent rotation of the spinal implant and to prevent vertebral bodies from moving apart as the spine is extended (Fig. 9, col. 2, lines 27-58, col. 6, lines 46-67, col. 7 and col. 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided an end cap as taught by Michelson in the Shapiro et al. implant to prevent rotation of the implant of the combination of Michelson and Shapiro et al. and to prevent the vertebral bodies from moving apart as the spine is extended.

Regarding claim 13, Michelson discloses the claimed invention except for two pawls. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided two pawls instead of one, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

The method steps of claims 28 and 29 are rendered obvious by the above discussion.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11, 14-17, 19-24 and 26-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11, 16-23 and 26-29 of copending Application No. 10/666,074. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claims of the present application and the claims of the copending application is that the claims of the copending application include many more elements and are thus more specific. Thus the invention of the claims of the copending application is in effect a "species" of the "generic" invention of the claims of the present application. It has been held that the generic invention is "anticipated" by the "species." See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the claims of the present application are anticipated by the claims of the copending application, they are not patentably distinct from the claims of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 12-13, 18 and 25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, 5,

7, 11-14, 16 and 19-22 of copending Application No. 10/666,074 ('074 herein) in view of Michelson (US 6,120,503).

Claims 4-5, 7, 11-14, 16 and 19-22 disclose all elements of the claimed invention except for wings on the end cap.

Michelson teaches an end cap with wings (16, 17) to prevent expulsion of an implant from the intervertebral space in which it is inserted (Fig. 9, col. 2, lines 27-58, col. 6, lines 46-67, col. 7 and col. 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided wings on the end cap of '074 to prevent expulsion of the implant of the combination of '074 and Michelson.

This is a provisional obviousness-type double patenting rejection.

Claims 7, 12-13, 18 and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 14 of U.S. Patent No. Jackson (US 6,440,170 or '170) in view of Michelson (US 6,120,503).

Claims 1 and 14 disclose all elements of the claimed invention except for wings and resilient pawls on the end cap.

Michelson teaches an end cap with wings (16, 17) to prevent expulsion of an implant from intervertebral space into which it is inserted (Fig. 9, col. 2, lines 27-58, col. 6, lines 46-67, col. 7 and col. 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided wings and resilient pawls on the end cap of the implant of the combination of '170 and Michelson to prevent expulsion of the implant.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-


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4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Arumadha Ramana*
June 21, 2005


KEVIN SHAVER
SUPERVISORY PATENT EXAMINER
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